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09/688,392	10/16/2000	Thomas C. Naratil	4034-20	2870

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EXAMINER

HAMILTON, LALITA M

ART UNIT PAPER NUMBER

3624

DATE MAILED: 01/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/688,392

Applicant(s)

NARATIL, THOMAS C.

Examiner

Lalita M Hamilton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on October 4, 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-16, and 18-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-16, and 18-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### **Summary**

On June 4, 2004, an Office Action was sent to the Applicant rejecting claims 1-17. On October 4, 2004, the Applicant responded by amending claims 1, 3, 5-9, 12-13, and 16, canceling claims 4 and 17, and adding new claims 18-19.

### ***Specification***

The objection set forth in the previous Office Action, mailed on June 4, 2004, has been withdrawn.

### ***Claim Rejections - 35 USC § 112***

The rejection set forth in the previous Office Action has been withdrawn.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 5-7, 10-12, 14-15, and 18-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Giovannoli (5,842,178), as set forth in the previous Office Action.

With regard to the amendment, Gionvannoli discloses including at least one response to a request for quotation (RFQ), forwarding at least one RFQ from a sender, wherein the sender comprises one of a first user and a second user acting on behalf of

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the first user, receiving at least one dealer response to the RFQ, and executing a trade based on a best RFQ (col.5, lines 10 to col.6, line 40). It is inherent that the first user may be a financial executive and that the second user may be a trader, since the buyers and sellers are not limited to one specific type/group that may participate.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8-9, 13, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giovannoli in view of Hoffman (US 2001/0039529).

Gionvannoli discloses the invention substantially as claimed; however, Gionvannoli does not disclose a system that allows a sender of a RFQ to improve the best response and execute a trade as a principal; price discovery module includes a time management system; the time management system comprising means for setting a first time limit that determines an amount of time for dealers to respond to the requests, means for setting a second time limit that determines an amount of time for a sender of a request to decide whether to accept a dealers response, and means for setting a third time limit that determines an amount of time, after the second time limit has passed, for the sender to inquire whether the response is still valid, or a method for trading taxable and non-taxable securities. Hoffman teaches a system and corresponding method for requesting quotation comprising a system that allows a

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sender of a RFQ to improve the best response and execute a trade as a principal (p.2, 21-23); a time management system; the time management system comprising means for setting a first time limit that determines an amount of time for dealers to respond to the requests, means for setting a second time limit that determines an amount of time for a sender of a request to decide whether to accept a dealers response, and means for setting a third time limit that determines an amount of time, after the second time limit has passed, for the sender to inquire whether the response is still valid (p.2, 21-23), and a method for trading taxable and non-taxable securities (p.2, 21-23—system and method may be used to trade any type of good or service). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a system that allows a sender of a RFQ to improve the best response and execute a trade as a principal; price discovery module includes a time management system; the time management system comprising means for setting a first time limit that determines an amount of time for dealers to respond to the requests, means for setting a second time limit that determines an amount of time for a sender of a request to decide whether to accept a dealers response, and means for setting a third time limit that determines an amount of time, after the second time limit has passed, for the sender to inquire whether the response is still valid, and a method for trading taxable and non-taxable securities, as taught by Hoffman into the invention disclosed by Giovannoli, to demonstrate that the RFQ of Giovannoli may be used in conjunction with securities or any product and to ensure that a sufficient amount of time is given for conducting the transaction until completion.

***Response to Arguments***

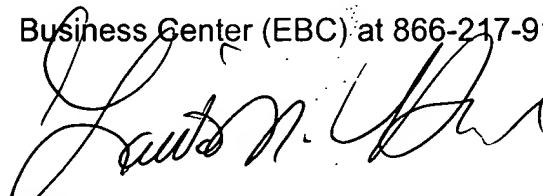
Applicant's arguments with respect to claims 1-3, 5-16, and 18-19 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lalita M Hamilton whose telephone number is (703) 306-5715. The examiner can normally be reached on Tuesday-Thursday (8:30-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



LMH